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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/925,627	09/09/97	FAUSTMAN	D 00786/036005

CLARK AND ELBING LLP  
176 FEDERAL STREET  
BOSTON MA 02110-2214

HM21/1002

EXAMINER

SMITH, L

ART UNIT

1648

PAPER NUMBER

4

DATE MAILED: 10/02/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>08/925,627</b>	Applicant(s) <b>Faustman</b>
	Examiner <b>Lynette R. F. Smith</b>	Group Art Unit <b>1648</b>

Responsive to communication(s) filed on \_\_\_\_\_.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1 and 36-88 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1 and 36-88 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## **DETAILED ACTION**

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 36-60, drawn to a composition comprising a cell, classified in class 530 subclass 350.
  - II. Claims 1, 61-83, drawn to a method of inhibiting rejection, classified in class 435, subclasses 366 and 372.
  - III. Claims 84-88, drawn to a method for preparing cells or tissue, classified in class 435, subclass 325.
2. Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process can be used on any cell-type from any species, including human.
3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

Art Unit: 1648

§ 806.05(h)). In the instant case the product can be used in the propagation and establishment of cell lines.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, divergent subject matter, the search for group I is not the same as the search for groups II and III and it would be an undue burden on the examiner to examiner all groups, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed invention which species appear in groups I and II:

a. LFA-3

b ICAM-1

c. MHC

d. different cell types.

e. masking, modifying or eliminating. The antigens recited (i.e. a, b, and c) recite different receptors on the various cell types which receptors have different structures and functions and are unobvious and patentably distinct each over the other. Additionally, d recites different cell types (such as liver, kidney, neuronal cells, etc) and e) recites different methods of modification. These cells have different functions and the methods comprise different steps in the procedure which are patentably distinct each over the other. Applicant is required to elect an antigen from a, b or c above, a cell type within subgroup d) and a method of modification within group e).

Art Unit: 1648

6. Applicant is required under 35 U.S.C. 121 to elect a disclosed species (as indicated above) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

7. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1648

9. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A fax cover sheet is attached to this Office action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Donald E. Adams, Ph.D., supervisory Patent Examiner at Donald.Adams@uspto.gov or 703-308-0570. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lynette F. Smith whose telephone number is (703) 308-3909.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams, can be reached on (703) 308-0570.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SMITH/lfs *AFS*  
October 1, 1998

*Lynette F. Smith*  
LYNETTE F. SMITH  
PRIMARY EXAMINER  
GROUP 1800



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

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